

<b>First Action Interview Pilot Program Pre-Interview Communication</b>	<b>Application No.</b> 10/532,704	<b>Applicant(s)</b> MCCLURKEN ET AL.	
	<b>Examiner</b> RONALD HUPCZEY, JR	<b>Art Unit</b> 3739	Page 1 of 2

*-The MAILING OR NOTIFICATION DATE of this communication appears on the cover sheet with the correspondence address -*

THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING OR NOTIFICATION DATE OF THIS COMMUNICATION.

**This time period for reply is extendable under 37 CFR 1.136(a) for only ONE additional MONTH.**

**This communication constitutes notice under 37 CFR 1.136(a)(1)(i).**

Applicant must, within the time period for reply, file: (1) A letter requesting not to have a first action interview; (2) A reply under 37 CFR 1.111 waiving the first action interview and First Action Interview Office Action; or (3) An Applicant Initiated Interview Request Form (PTOL-413A) electronically via EFS-Web, accompanied by a proposed amendment or arguments, and schedule the interview within 2 months from the filing of the request. A failure to respond to this communication will be treated as a request not to have an interview. If applicant waives the First Action Interview Office Action, the instant Pre-Interview Communication is deemed the first Office Action on the Merits. The next subsequent Office action may be made final if appropriate. See MPEP 706.07(a).

#### Disposition of Claims

- 3) ☒ Claim(s) 19-38 is/are pending in the application.  
     3a) Of the above claim(s) 33-38 is/are withdrawn from consideration.
- 4) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 5) ☒ Claim(s) 19-32 is/are rejected.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 7) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 8) ☐ The specification is objected to by the Examiner.
- 9) ☒ The drawing(s) filed on 26 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

#### Contact Information

Examiner's Telephone Number: (571)270-5534  
 Examiner's Typical Work Schedule: Monday - Friday, 9 A.M. to 5 P.M.  
 Supervisor's Name: Linda Dvorak  
 Supervisor's Telephone Number: 571-272-4764

#### Attachment(s)

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| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/26/05, 04/06/06, 05/22/08</u> | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date _____<br>5) <input type="checkbox"/> Notice of Informal Patent Application<br>6) <input type="checkbox"/> Other: _____ |
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<b>First Action Interview Pilot Program Pre-Interview Communication</b>	<b>Application No.</b> 10532704		<b>Applicant(s)</b> MCCLURKEN ET AL.	
	<b>Examiner</b> RONALD HUPCZEY, JR		<b>Art Unit</b> 3739	Page 2 of

**Notification of Rejection(s) and/or Objection(s)**

#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection
1	20-21		35 USC 112, 2nd	Claim 19 sets forth scissors which comprise an end effector with a first and second blade member and a fluid passage. Each of claim 20 and 21 as currently written would require a second either monopolar or laparoscopic electrosurgical scissors in addition to the
2	19-22, 24-29, 31-32	A	35 USC 102(b)	Claim 19: (see figures 1 and 26, col. 6; 50-64, col. 8; 42-64, jaw unit 12, jaws 170, pivot pin 192, terminal pin 94, passage formed by flat 146 on rod 50 and tube 51, fluid exit at end of flat 146) 20-21: (see figure 1 and col. 6; 50-64) continued below
3	23	A, B	35 USC 103(a)	Claim 23: A fails to disclose insulative material on the exterior surface of the blade members. B discloses a similar electrosurgical device (see figure 2, scissors 20) with outer surfaces comprising insulative material (layer 27).
4	30	A, C	35 USC 103(a)	Claim 30: While A shows portions of the jaws 170 as curved, A fails to show each complete jaw as having a curved shape. C presents a commonly utilized curved jaw shape for a similar electrosurgical device in figure 2 which would be an obvious design

**Expanded Discussion/Commentary**

1		scissors recited in claim 19. This is contrary to the disclosure provided by Applicant in the specification and drawings.
2		22: (see figure 20, rounded noses 177) 24: (flats of jaws 176 with teeth 181) 25-27: (figure 8 and col. 9; 5-18, extension tube 51 with space formed therein and distal opening at end of tube) 28: (figures 13 and 20, arm 163) 29: (figures 13 and 20, functional relation of 51, 50 and 163 with col. 9; 5-18) 31-32: (figure 20, surfaces of jaws opposite teeth 181, "configured to" language seen as functional/intended use recitation which A is capable of performing)
3		It would have been obvious to provide such an insulative layer as that of B to the device of A to direct treatment to only a portion of tissue in contact with an uninsulated portion of the scissors thereby reducing damage to non-target tissue. B provides for such motivation in providing the insulative layer to its device (see col. 5; 29-48).
4		consideration by one of ordinary skill in the art. C further discloses in col. 4; 35-45 the recognized swapping from a straight to a curved blade design.
		In the attached Notice of References cited, documents D-I are considered of particular relevance also to the instant invention.
		An oral election of Group I, claims 19-32 without traverse was made over the phone by Applicant's representative Michael Gallagher on November 19th, 2009. Claims 33-38 are therefore withdrawn from consideration as being directed to non-elected Group II.

<b>DATE:</b> 11/19/2009	/Ronald J. Hupczey/ Examiner, Art Unit 3739	/Linda C Dvorak/ Supervisory Patent Examiner, Art Unit 3739
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